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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): STL11083

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on April 17, 2006

Signature: Diana C. Anderson

Typed or printed name: Diana C. Anderson

Application Number	Filed
10/602,254	June 23, 2003

First Named Inventor: Travis D. Fox

Art Unit	Examiner
2185	Hong Chong Kim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 39,297
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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4/17/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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PATENT
Dkt. STL11083

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Travis D. Fox, Edwin S. Olds, Mark A. Gaertner and Abbas Ali		
Assignee:	Seagate Technology LLC		
Application No.:	10/602,254	Group Art Unit:	2185
Filed:	June 23, 2003	Examiner:	H.C. KIM

For: TRANSFERRING SPECULATIVE DATA IN LIEU OF REQUESTED DATA IN A DATA TRANSFER OPERATION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ACCOMPANYING ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper constitutes accompanying arguments for a pre-appeal brief request for review for the above identified U.S. patent application. A Notice of Appeal and a Pre-Appeal Brief Request for Review have been filed herewith.

Present Status of Claims

Claims 1-13 and 21-28 are pending in the application. Of these claims:

1. Claims 1-13 and 25-28 stand finally rejected under 35 U.S.C. §112, first paragraph, for failure to comply with the written description requirement;

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

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Diana C Anderson
Signature

Date: April 17, 2006

Diana C. Anderson
(type or print name of person certifying)

#355433

2. Claims 1-13 and 21-28 stand finally rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2003/0105919 to Olds et al. ("Olds '919"); and
3. Independent claims 1, 21 and 25 stand finally rejected under 35 U.S.C. §103(a) as being obvious over U.S. Published Patent Application No. US2002/0052985 to Furuumi et al. ("Furuumi '985") in view of "The Cache Memory Book" by Jim Handy ("Handy").

Post-final clarifying amendments to independent claims 1 and 25 were proposed but not entered, and so this amendment does not form a portion of the present review.

Claim Language at Issue

The language *"delaying execution of a second data transfer command to transfer speculative data in lieu thereof"* of independent claims 1 and 25 is generally at issue with regard to the §112 written description rejection.

The above language of claims 1 and 25, as well as the language *"transferring speculative data instead of second data associated with a second pending command"* of independent claim 21, are generally at issue with regard to the §102 and §103 rejections.

Summary of Arguments in Favor of Patentability

The Applicant respectfully submits that the case is not ripe for appeal on the basis of clear legal and factual error on the part of the Examiner. This can be readily demonstrated by the following points.

1. The Examiner has sustained the final rejection under 35 U.S.C. §112, first paragraph for failure to meet the written description requirement even though clear support for the claim language in the specification as originally filed has been shown by the Applicant.

a. The legal test for whether the written description requirement of §112, first paragraph is met is whether *"one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented."* *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F. 3d 774, 779 (Fed. Cir. 2002); see Applicant's Response filed February 15, 2006, pp. 7-10.

b. The phrase "*delaying execution of a second data transfer command to transfer speculative data in lieu thereof*" of claims 1 and 25 would readily be recognized by one having skill in the art as being disclosed in the specification such as at page 8, lines 18-22 ("*expanding speculative data...necessarily means skipping the next best access command...in the command queue in favor of acquiring additional speculative data.*"). See also Applicant's 2/15/06 Response, p. 9, lines 3-11.

c. In an Advisory Action mailed February 28, 2006, the Examiner failed to withdraw the §112, first paragraph rejection, which means that the rejection remains in place without supporting rationale. Advisory Action, p. 2.

d. As a result, the Examiner has failed to correctly apply the applicable law in the present case. The final rejection under §112, first paragraph is accordingly without merit and constitutes reversible error.

2. The Examiner's sustaining of the final rejection under 35 U.S.C. §102 as being anticipated by Olds '919 includes an improper reliance on the drawings thereof without regard to the associated explicit teachings of the specification.

a. As previously pointed out by the Applicant, Olds '919 discloses three different alternatives in FIGS. 4-6 thereof with regard to an interval of time between the transfer of first and second data blocks 150, 154 (DATA1 and DATA2 in FIGS. 4-6, Olds '919). In each case, the same blocks 150, 154 are used and are transferred at the same respective times. See Applicant's 2/15/06 Response, pp. 10-11; Applicant's 10/26/05 Response, pp. 11-12. See also paragraph [0048] in Olds '919.

b. Since in each case the DATA2 are transferred at the same time, it is conclusive that Olds '919 fails to disclose "*delaying execution of a second data transfer command to transfer speculative data in lieu thereof*" as claimed by claims 1 and 25, and fails to disclose "*transferring speculative data instead of second data associated with a second pending command*" as claimed by claim 21. See Applicant's 2/15/06 Response, pp. 10-11.

c. Nevertheless, in the 2/28/06 Advisory Action, the Examiner sustained the final rejection on the basis that blocks 154 in FIGS. 4-6 of Olds '919 are

skewed (*"it appears that beginning of DATA 2 transfer time in each operation is not started at the same time."* – Advisory Action, p. 2, line 7).

d. It is long settled that anticipation of claim terms cannot be shown by relying on patent drawings apart from the associated disclosure in the specification. See *Nystrom v. TREX Co.*, 76 USPQ2d 1481 (Fed Cir. 2005); *Hockerson-Halberstadt Inc. v. Avia Group International Inc.*, 222 F.3d 951 (Fed. Cir. 2000). Since Olds '919 identifies these as the same data blocks in each figure, no amount of visual examination of the graphical representations of the blocks will avail to prove otherwise.

e. The anticipation rejection of claims 1-13 and 21-28 in view of Olds '919 is therefore deficient on both legal and factual grounds, and a *prima facie* case of anticipation has not been established.

3. The Examiner's sustaining of the final rejection under 35 U.S.C. §103 as being obvious over Furuumi '985 in view of Handy is based on a misplaced technical characterization of Handy.

a. The Applicant demonstrated that the Examiner failed to establish a *prima facie* case of obviousness of claims 1, 21 and 25 in the Applicant's 2/15/06 Response on the basis that not all of the limitations were met by the combined references, and on the basis that there is nothing absent improper hindsight reconstruction to motivate one skilled in the art to arrive at the claimed combination from these references. 2/15/06 Response, p. 12, line 18 to p. 13, line 12.

b. In the 2/28/06 Advisory Action, the Examiner sustained the final rejection by stating "*Handy discloses delaying executing of a second data transfer command to transfer speculative data in lieu thereof (pp. 6, 72 and 84, spatial locality and reading in additional cache data (prefetching) during cache miss read on this limitation.*" Advisory Action, p. 2, lines 7-9 (emphasis added).

c. It is a *non-sequitur* for the Examiner to assert that "spatial locality" and "reading in additional cache data during a cache miss" as taught by Handy somehow add up to teaching or suggesting the claimed subject matter. At page 6, Handy defines spatial locality (lines 28-31); at page 72, Handy

suggests that due to spatial locality, it may be helpful after a cache miss to retrieve the requested word and also bring in some additional nearby word as well (lines 21-24); at page 84, Handy teaches Class 2 caches that carry out automated prefetch operations in the absence of a pending command (lines 10-16). These have nothing to do with the claimed subject matter.

d. The Applicant respectfully submits that the Examiner either fails to understand the art, or is mischaracterizing the relevance of Handy in making up for the deficiencies of Furuumi '985. Regardless, a *prima facie* case of obviousness has not been established and the rejection is based on clear legal and factual error.

Thus, the case is not ripe for appeal as the final rejection is without basis on the following grounds:

1. Clear legal error exists with regard to the written description requirement rejection of claims 1-13 and 25-28;
2. Clear legal and factual error exists with regard to the anticipation rejection of claims 1-13 and 21-28; and
3. Clear legal and factual error exists with regard to the obviousness rejection of the independent claims 1, 21 and 25.

Reconsideration of the final rejection and allowance of all pending claims 1-13 and 21-28 are therefore respectfully solicited.

Respectfully submitted,

By: _____

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